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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,382

Applicant(s)

BISHAY ET AL.

Examiner

George R Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-130 is/are pending in the application.
- 4a) Of the above claim(s) 20,21,30,31,34,35,85,86 and 94-130 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19,22-29,32,33,36-84 and 87-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-93, drawn to a support apparatus, classified in class 607, subclass 115.
- II. Claims 94-130, drawn to a therapy or monitoring support method, classified in class 607, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process not involving delivering therapy or for monitoring, but for electric shock for immobilization. In addition, the process as claimed can be practiced by another materially different apparatus not involving two links between the care unit and coupler, but the same link for delivering simultaneous therapy.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Embodiments 1-3, represented by the couplers used for electrical therapy, drug therapy, or monitoring, respectively.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no claims that are allowable and generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with John Wechkin on 8/6/02 a provisional election was made without traverse to prosecute the invention of group I, embodiment 1, claims 1-19, 22-29, 32, 33, 36-84, 87-93. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20, 21, 30, 31, 34, 35, 85, 86, 94-130 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19, 22-29, 32, 33, 36-84, 87-93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 9, 16, and 83, "and/or" is vague since the scope of the claim is unclear; "a first coupling position" and "a second coupling position" are inferentially included and have not been positively recited. It is unclear if applicant is claiming the coupling positions. It is suggested to use "adapted to be proximate a first coupling position". In the claim, "a first coupler location" and "a second coupler location" both being configured to removably carry couplers is vague. The "locations" are nothing but points/places on the support and they have no structure to be "configured" to perform any function. The specification does not lend any support for the "locations" have any function.

In claims 2, 10, and 17 the claims are vague since claim 1 has the "locations" performing the function of removably carrying the couplers but claims 2/10/17 now has the engagement members performing this function.

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In claims 3, 11, 13, 18, 22, 44, 47 the claims are incomplete for omitting essential cooperative relationship between elements amounting to a gap in the structure for not connecting the couplers to the rest of the structure.

In claims 4, 12, 19, 28, 47, and 87, "contact positioned to connect to a ... probe" is inferentially including the percutaneous electrical probe. It is suggested to use "positioned for connecting to a ... probe".

In claims 7, 15, 26, 41, 64, 76, and 93, the claims are vague since the claims are limiting the "positions" which have not been positively recited.

In claim 8, "the first coupling location" lacks antecedent basis.

In claim 16, "the first coupler location being positioned closer than the second coupler location to the first coupling position" is vague since this is a relative phrase. The first coupling position has not been positively recited (and can not be positively recited since it is a position on the body) and therefore it is unclear how the first location can be closer.

In claim 27, "and/or" is vague; "a coupling region", "first coupling position" and "second coupling position" are inferentially included; "the first engagement member being positioned closer than the second engagement member to the first coupling position" is vague since this is a relative phrase since the position has not been set forth.

In claim 32, "operatively coupled to the recipient" is vague since it sounds as if there is a positive connection to the human body. Apparatus claims can not claim a connection to the body. It is suggested to use "adapted to be operatively coupled...".

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In claim 36, "wherein the first coupler has an aperture" is vague since the first coupler has not been positively recited. It is suggested to place the first coupler in functional terms relative to the engagement member.

In claims 40 and 82, the claims are vague since the coupling positions have not been positively recited and it can not be determined how the members correspond to the positions.

In claim 42, "of a central axis" is vague since it does not state what element it is a central axis of.

In claim 43, the claim is vague since it is limiting the coupling positions on the body and since the positions have not been positively recited.

In claims 50-52, the claims are vague since "the first coupler" has not been positively recited and therefore can not be further limited.

In claims 53 and 65, "a first coupling position" and "a second coupling position" are inferentially included.

In claims 55, 67, 79 "to insert a percutaneous electrode" is inferentially including the electrode and connection to the recipient. It is suggested to use "for inserting...".

In claim 77, "a coupling region of the back" is inferentially included.

In claim 82, "the coupling positions" lack antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in-

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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-3, 6-11, 14-18, 23-27, 36-44, 47-49, 83, 84, and 89-93 are rejected under 35 U.S.C. 102(e) as being anticipated by Del Mar et al (6117077). Del Mar shows the engagement members as prongs/posts in connectors 120 and 102 and is capable of meeting the functional use recitations presented in the claims.

Claims 1-3, 5-11, 13-18, 22, 24-27, 36-38, 40-44, 48, 83, 84, and 89-93 are rejected under 35 U.S.C. 102(b) as being anticipated by Russek (4381012). Russek shows the engagement members as wires and connectors, 10 and 10', and couplers as electrodes 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Mar et al (or Russek).

Del Mar (or Russek) discloses the claimed invention except for the different color indicators or visual indicators for the engagement posts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the physiological recorder as taught by Del Mar (or Russek), with the use of different color indicators or visual indicators for the engagement posts since it was known in the art that different color indicators or visual indicators are used for connectors on medical device to prevent the mix-up of cables used on the devices and ensure the proper placement of cables.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are 703 306-4520 for regular communications and 703 306-4520 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

George R Evanisko
Primary Examiner
Art Unit 3762

8/12/2

GRE
August 12, 2002